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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---|------------------|
| 10/693,197 | 10/24/2003 | Mark T. Devlin | EI-7608 | 2333 |
| 63970 7590 01/08/2007 MIN, HSIEH & HACK LLP (CUSTOMER NO. W/NEW MARKET) 1951 KIDWELL DRIVE SUITE 550 TYSONS CORNER, VA 22182 | | | EXAMINER SANDERS, KRIELLION ANTIONETTE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1714 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/08/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/693,197

Applicant(s)

DEVLIN ET AL.

Examiner

Kriellion A. Sanders

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace et al, US Patent No. 5492638 in view of Srinivasan et al, US Patent No. 5358650 and Walsh, US Patent No. 4,584,113.

The rejection is repeated for reasons of record.

Wallace et al discloses an oil composition that is used to improve the gearshift performance in a synchromesh transmission. The oil composition comprises:

- ◆ Mineral or synthetic ester oil
- ◆ Ashless dispersant
- ◆ Sulphur containing anti-wear or extreme pressure agent
- ◆ Phosphorus and nitrogen containing anti-wear or extreme pressure agent
- ◆ Overbased alkali or alkaline based carboxylate, sulphonate, or sulphurized phenate

See claims 1-3.

- ◆ The mineral or synthetic ester oil corresponds to applicant's component e.
- ◆ The ashless dispersant corresponds to applicant's component d.
- ◆ The sulphur containing anti-wear or extreme pressure agent corresponds to applicant's component a.

- ◆ The phosphorus and nitrogen containing anti-wear or extreme pressure agent corresponds to applicant's component b.
- ◆ The overbased alkali or alkaline based carboxylate, sulphonate, or sulfurized phenate corresponds to applicant's component a.

The patent does not teach applicant's friction modifying compound, c. See col. 1, line 30 through col. 9, line 52.

Srinivasan et al also discloses oil compositions useful for lubricating gears. The compositions include among other things, a sulfur containing antiwear or extreme pressure agent, a phosphorus containing antiwear or extreme pressure agent, and an ashless dispersant. The patent documents these components to be conventional additives for lubricating compositions. See the abstract and claim 1.

Walsh et al discloses lubricants that contain sulfurized components of a mixture of a terpene and a polyolefin. These reactants may contain amine and/or amide groups. See col. 3, lines 1-15. Other conventional additives such as soaps, dispersants, extreme pressure agents and anti-wear agents are also included in the compositions. See col. 15, line 3 through col. 16, line 58.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the sulfurized components of Walsh that additionally contain amine or amide groups in the conventional lubricant compositions of Wallace et al with the expectation of achieving improved antioxidant, anti-wear and extreme pressure properties. The ordinary practitioner of this art would have looked to Wallace et al and Walsh to determine optimal ratios of additives. See Wallace et al at col. 5, line 64 through col. 6, line 40. The weight percentages

given do not include diluents and take into account that some components have dual functions and should be adjusted accordingly. The resulting compositions would necessarily result in the base oil having a viscosity of SAE 50W to SAE 250, because the components are essentially the same as applicant's claimed components.

Response to Arguments

3. Applicant's arguments filed 10/24/06 have been fully considered but they are not persuasive. Applicant argues that the polyalkylene polyamine of Srinivisan et al is not present as an individual component, much less as a friction-modifying compound. Applicant states that, "At most, Srinivasan teaches a modified polyalkylene polyamine, if that". Applicant is advised that this component meets the requirements of applicant's component) c. Applicant's claim 1 requires as component c) a friction modifying compound comprising an alkylene amine compound. Srinivisan et al discloses a component comprising an alkylene amine compound. Applicant's claims do not require that component c) be present as an individual ingredient. Applicant argues further that Srinivasan et al only teaches using the polyalkylene polyamine to form a dispersant. A component and its function may not be separated. The function of a component is inherent whether it is specified within the patented disclosure or not.
4. Applicant further argues Walsh does not teach or suggest using an unreacted terpene or olefinic compound in a fully finished composition. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the use of an unreacted terpene or olefinic compound in a fully finished composition) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Again, since a component and its functions may not be separated, the polyalkylene amines of Walsh would possess any friction modifying capabilities ordinarily associated with the compounds.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kriellion A. Sanders
Primary Examiner
Art Unit 1714

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